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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

CHAMPAGNE, DONALD

ART UNIT PAPER NUMBER

3622

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/716,563

Applicant(s)

FERBER, JOHN

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-11, 13-15, 17, 18 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-15, 17, 18, 22, 23, 26 and 27 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7, 8, 20, 21, 24 and 25 is/are rejected.
- 7) ☒ Claim(s) 3-5 and 9-11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 7, 8, 20, 21, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Logan et al. (US005721827A).
3. Logan et al. teaches (independent claims 1 and 7) a method and system for distributing personalized, multimedia information, including advertising, to a subscriber over the Internet (col. 1 lines 39-47, col. 3 line 32 and col. 4 lines 26-27), which reads on e-mail-based opt-in marketing, the method comprising: providing an ad server/webmaster server (*host server 101*), database **130** and subscriber device (*player 103*) connected to the Internet (Fig. 1 and col. 3 lines 1-2 and col. 4 lines 21-27); providing software instructions on each webmaster server/*host server 101* for collecting an e-mail address for said subscriber device (when the subscriber first subscribes) and storing said e-mail address on said database by having an operator of said subscriber device input said e-mail address (*post subscriber supplied information*, col. 6 lines 48-56) and make a selection to opt-in for delivery of an ezine from a plurality of available ezines.
4. The server *periodically* provides information, so any continuing series so delivered (e.g., *serialized programs*, col. 18 lines 47-55, of news or music, col. 28 line 59 to col. 29 line 19) reads on an ezine. The subscriber's Internet address reads on e-mail address. The specification does not specify a "clear definition" for "e-mail" (MPEP § 2111.01). In such a case, the examiner is required to give the term "e-mail" its broadest reasonable interpretation, which the examiner judges to be the Microsoft dictionary definition (Microsoft Press Computer Dictionary).
5. Logan et al. also teaches at the citations given above claims 2, 8, 24 and 25. Logan et al. also teaches claims 20 and 21 (col. 18 lines 41-46 and col. 25 lines 41-42).

Allowable Subject Matter

6. Claims 13-15, 17, 18, 22, 23, 26 and 27 are allowed.
7. Claims 3-5 and 9-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. The allowance is based on search of the US patent literature only. The examiner will search the non-patent literature after applicant has put the claims into condition for allowance. Allowance is further dependent on approval by an allowance conference.
9. The following is an examiner's statement of reasons for the indication of allowable subject matter and allowance: the closest prior art, Logan et al. (US005721827A), does not teach or suggest providing incentives to a subscriber for responding to ads, or providing compensation for referrals. Sullivan et al. (US006663105B1) teaches these limitations, but the prior art does not teach or suggest adding the teachings of Sullivan et al. to those of Logan et al.

Conclusion


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
11. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.
12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

13. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

20 March 2006


DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622